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SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH/EBAY	HILLERY, NATHAN	
P.O. BOX 2938		
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PTOL-90A (Rev. 10/06)

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/734,045
Filing Date: December 12, 2000
Appellant(s): GORELICK ET AL.

Mark R. Vatuone
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/11/06 appealing from the Office action mailed 12/27/05.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

Claims 5, 6, 8 and 9 have been canceled.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection filed on 3/1/06 has been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: only claims 1 – 4 and 7 rejected under 35 USC 103(a) are to be reviewed on appeal.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6092074   Rodkin et al.   7-2000

6651058   Sundaresan et al.   11-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1 – 4, 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Rodkin et al. (US 6092074 A) and in further view of Sundaresan (US 6651058 B1).

Regarding independent claim 1, Rodkin et al. teach that *the content server*

may provide hypertext links only for character strings in the on-line article which match a

local database of stored character strings at the content server, and/or which have no

corresponding destination address. If a character string in the on-line article does not

match the database of stored character strings or has no corresponding destination

address, no link is provided (Column 12, lines 43 – 49) and that *the Intelligent*

Annotator^TM 520 may insert the destination address itself, e.g., a URL into the article to

be annotated (Column 19, lines 33 – 36), which meet the limitation of **comparing the**

text to one or more character strings contained in a database in order to identify

specific character strings from the database that appear in the text, wherein each

of the character strings has an associated hyperlink that is also contained in the database; and for each of the identified character strings contained in the text, inserting the associated hyperlink into the webpage.

Rodkin et al. teach that *the destination addresses in the database are changed without changing the annotated article. For example, the anchor code for "quote" mentioned above may initially reference the destination address "http://www.quotes.com" which is provided by Company A. However, a competing company, such as a stockbroker, Company B, may pay the central server administrator to update the master destination and expiration database with the preferred destination address of Company B, e.g., "http://www.companyB.com". When the next periodic update of the content servers occurs, the central server will transmit the updated destination address to the content server for storage in the destination and expiration database. Then, the next time a Web surfer activates the anchor code for "quote" mentioned above, a link to the preferred destination address of Company B will occur* (Column 17, lines 49 – 67), which meet the limitation of **designating a name for a product and storing the name of the product as one of the character strings in the database.**

Rodkin et al. do not explicitly teach **communicating the name of the product to a producer of the text, wherein the name of the product is designated from a plurality of names of the product that are utilized by the producer of the text.**

Sundaresan teaches that *FIG. 5 illustrates an exemplary system for the automatic mining of new relationships that uses the automatic and iterative recognition*

of new binary relations through phrases that embody related pairs by applying

lexicographic and statistical techniques to classify the relations, and further by applying

a minimal amount of domain knowledge of the relevance of the terms and relations.

New terms are obtained from relations discovered by the system for automatic mining of

patterns and relations of the same kind by selecting an item (or a column) of a pair. For

example, for the purpose of identifying relevant products, one can obtain all the product

names from the product item (or column) of (company, product) pairs of a production

relationship (Column 8, lines 22 – 34), which meet the limitation of **communicating the**

name of the product to a producer of the text, wherein the name of the product is

designated from a plurality of names of the product that are utilized by the

producer of the text.

It would have been obvious to one of ordinary skill in the art at the time of the

invention to combine the invention of Rodkin et al. with that of Sundaresan because

such a combination would allow the users of Rodkin et al. the benefit of *an automatic*

mining system to discover terms that are relevant to a given target topic from a large

database (Column 3, lines 34 – 36).

Regarding dependent claim 2, Rodkin et al. do not explicitly teach that **the text**

comprises content of a newsgroup article.

However, Rodkin et al. do teach that *the content server processes an on-line text*

article using an executable Intelligent Annotator^{TM} to automatically associate hypertext

anchor codes with various character strings in the article. A resulting on-line article with

hypertext can be produced and stored locally on the content server (Column 12, lines

31 – 36).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to be motivated to use the invention of Rodkin et al. on newsgroup articles so

that the users can process all types of on-line text articles including newsgroup articles.

Regarding dependent claims 3 and 4, Rodkin et al. teach that *a computer user*

viewing the page can access the referenced document simply by selecting the

highlighted text in the instant file, e.g., by clicking on the highlighted text with a mouse

or other pointing device. A markup language anchor, or markup language hyperlink, is

the reference icon on a Web page which links a user's Web browser to relevant

information. An HTML anchor, or HTML hyperlink, is the underlined text on a Web page

which links a user's Web browser to another location. (Column 1, lines 26 – 35) and that

in the above examples where it was indicated that a content server administrator input

530 may be used, generally such input is optional as the present invention provides the

capability for fully automatic insertion of hypertext link codes into the article to be

annotated (Column 20, lines 55 – 59), which meet the limitation of **the hyperlinks are**

inserted into the text of the webpage and for **reconfiguring computer code used to**

form the webpage such that the identified character strings change appearance

and the associated hyperlink is selectable by a user that selects and clicks on the

identified character strings.

Regarding dependent claim 7, Rodkin et al. do not explicitly teach that **only the first occurrence in the text of the character string is hyperlinked**.

However, it would have been obvious to one of ordinary skill in the art at the time of the invention to be motivated to use the invention of Rodkin et al. in that way because the skilled artisan would not want the user to believe that the other occurrences in the text of any character string are different links from each other and the first occurrence; thereby, allowing the user to checkout the other links and not have to constantly revisit links that the user has already seen.

(10) Response to Argument

Appellant argues that Sundaresan does not teach the communication of a product name to a producer of text because Sundaresan describes a system that obtains a new term from a product relationship and does not communicate the new term to a producer of the text (Appeal Brief, p 10, first paragraph).

The Office disagrees.

First, appellant admits that Sundaresan describes a system that obtains a new term from a product relationship but appellant believes that the system of Sundaresan does not communicate the new term to "a producer of text" (Appeal brief, p 10, first paragraph, last line). In contradistinction Sundaresan does teach that *for the purpose of identifying relevant products, one can obtain all the product names from the product item (or column) of (company, product) pairs of a production relationship* (Column 8, lines 22 – 34). Thus, Sundaresan teaches that "one", as in a person or entity, can obtain all the product names of a product item.

It should be noted that appellant is not fully appreciating the Sundaresan reference. As discussed above, Sundaresan teaches that one can obtain all product names of a product item, which meets the limitation of communication of a product name, since the skilled artisan would have recognized that the product name is communicated in some way to the user so that the user or "one" can obtain the name.

Appellant argues that Sundaresan does not teach the communication of a product name to a producer of text because Sundaresan cannot be said to describe "a producer of text" (Appeal Brief, p 10, second paragraph).

The Office disagrees.

Although the Specification discloses that the host may coordinate with producers of text documents so that the producers of text consistently use the shortname for a product (0042), the Specification does not purposefully and definitively define the term "producer of text". Consequently, within the broadest, reasonable interpretation of the term "producer of text" in light of the specification, the Office has interpreted the term "producer of text" to be any person or entity that authors, edits, or otherwise "produces" some form of text in a computer or on a physical medium such as paper. Since Sundaresan teaches a user-defined threshold determines the significance of the topic (Column 7, lines 45 – 50), the invention of Sundaresan meets the limitation because the user defines a threshold thus the user produces text, making the user a "producer of text". In summary, "one" or the user can obtain all the product names of a product item

from the system of Sundaresan thus meeting the limitation of the communication of a product name to a producer of text.

Appellant argues that Sundaresan does not describe the designation of a name of a product from a plurality of names of the same product because Sundaresan may be said to describe different products because the production relationships describe different producing companies (p 10, third paragraph).

The Office disagrees.

First, Sundaresan teaches that *new terms are obtained from relations discovered by the system for automatic mining of patterns and relations of the same kind by selecting an item of a pair. For example, for the purpose of identifying relevant products, one can obtain all the product names from the product item of (company, product) pairs of a production relationship* (Column 8, lines 22 – 34). The Office still maintains that the teachings of Sundaresan meet the limitation of the designation of a name of a product from a plurality of names of the same product, since Sundaresan explicitly teaches that new terms are obtained from relations of the same kind by selecting an item of a pair – one example of a pair is (company, product).

Even if, for the sake of argument, the Office were to believe Appellant's interpretation of the reference that Sundaresan teaches different companies, then Sundaresan still meets the claim limitation for at least two reasons. For one, nothing in the claim precludes the use of different companies. Secondly, different companies can still produce the same product – tissue, candles, etc.

Furthermore, it should be noted that the Specification provides no guidance for interpreting the designation of a product from a plurality of names of the same product. The only support that can be found for "providing a designation" is in original claim 5, which has since been cancelled.

Appellant argues that the rejection of claims 1 – 4 and 7 was erroneous because the Final Office Action does not determine whether the claimed invention as a whole would have been obvious (p 11, last paragraph).

The Office does not understand Appellant's argument. Specifically, appellant goes on to say that the Final Office Action and the Advisory Action have alleged that a number of differences between the prior art and the limitations of independent claim 1 would have been obvious.

The Office disagrees. All the limitations of claim 1 have been met by disclosures and/or teachings found in Rodkin et al. and/or Sundaresan as clearly illustrated in the grounds of rejection above. The only obvious statement used to reject claim 1 is in the motivation to combine the references.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Nathan Hillery

Conferees:

H. Herndon

Heather R. Herndon
Supervisory Patent Examiner
Technology Center 2100

Heather Herndon, Supervisory Patent Examiner – AU 2176

Steve Hong, Supervisory Patent Examiner – AU 2178